

REMARKS

Claims 1-19 are pending and stand rejected. Claims 1 and 16 have been amended herein to recite wherein the flange extends upwardly at an angle of about 90 degrees. Support for these amendments can be found in the specification at, for example, page 3, lines 27-29. No new matter has been added.

In light of the above amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 1-19.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-19 under 35 U.S.C. § 103(a), alleging that they are unpatentable over the Perlman patent (U.S. Patent No. 5,225,165). The Examiner cited MPEP § 2144.04(VI)(C), and alleged that it would have been obvious to relocate the flange of the microtube described in the Perlman reference “since it has been held that rearranging parts of an invention involves only routine skill in the art.” (Office Action at pages 3 and 5.) The Examiner further alleged that “it is a matter of obvious design choice to rearrange the flange disclosed in Perlman in order to facilitate an opening operation.” (Advisory Action at page 2.)

Applicants respectfully disagree. The previously recited flange is not an “obvious design choice.” Nevertheless, without acquiescing to the Examiner’s rejection and to further prosecution, Applicants have herein amended independent claims 1 and 16 to recite a flange that extends upwardly at an angle of about 90 degrees.

As the Supreme Court recently clarified, obviousness under § 103 requires consideration of the factors set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), including an analysis of the scope and content of the prior art and the differences between the claimed subject matter and the prior art. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Moreover, and importantly, the Examiner must set forth an *explicit rationale* for why one having ordinary skill in the art would have combined the elements in the manner claimed. *Id.* at 418. In the present case, the Examiner has failed to set forth an explicit rationale as to why a person of ordinary skill in the art would have found it obvious to rearrange the microtube of the Perlman patent to have a flange positioned within the half of the lid proximal to the hinged end, extending upwardly at an angle of about 90 degrees, as recited in present claims 1 and 16. In fact,

Applicants submit that a person of ordinary skill in the art reading the Perlman patent would have had no motivation to rearrange the microtube disclosed therein. This is particularly true given that at no point does the Perlman patent teach or suggest a flange positioned within the half of the lid *proximal* to the hinge or a flange that extends upwardly at an angle of about 90 degrees, as recited in the present claims. To the contrary, the Perlman patent specifically discloses a lid extension that is “attached within the half of the lid *distal* from the hinge” and “lies at an *obtuse* angle with respect to the hinge.” *See*, column 3, lines 10-12 and 65-66, and column 6, lines 17-20 and 45-47 (emphasis added). Moreover, the Perlman lid extension has an upward projection “preferably angled at 20-80 degrees elevation above a generally horizontal plane.” *See*, column 3, lines 1-3. The Perlman patent further discloses that in the preferred arrangement, the lid extension is “on or near the original lifting tab and *relatively far from the hinge*,” which increases leverage and facilitates opening of the microtube. *See*, column 3, lines 12-16, and column 6, lines 47-50. Given the Perlman patent’s express preference for such placement of the lid extension, a person having ordinary skill in the art would have had no motivation to relocate or reconfigure the extension.

To bridge the gap between the Perlman patent and the present claims, the Examiner asserted that relocation of the Perlman flange on the lid would have been an obvious rearrangement of parts of the invention. (Office Action at page 3.) The Examiner’s assertion is not sufficient where, as here, there is no teaching or suggestion in the cited reference that would motivate a person having ordinary skill in the art to relocate the flange in that manner.

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.

Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added). Without any motivation or reason for one having ordinary skill in the art to make the necessary rearrangements, the present claims are not obvious over the Perlman patent.

Further, it is not proper to reject the present claims as obvious when the specifically recited limitation is a critical feature of the present invention and not merely a “design choice.” MPEP § 2144.04. In the present case, provision of a flange that is positioned within the half of

the lid proximal to the hinge and extends upwardly at an angle of about 90 degrees is not a simple matter of design choice. The benefits of positioning the flange in the half of the lid proximal to the hinge and extending upwardly at an angle of about 90 degrees are at least two-fold. First, mechanical force can be applied downwardly to the upper surface of the flange to open the lid with ease and with only one hand. Second, after the lid is so opened, it can act as a shield between the object applying the mechanical force (e.g., the thumb of the handler) and the tube opening, thereby avoiding contamination of the tube or its contents. *See*, e.g., Applicants' specification at page 4, lines 11-14 and 18-22; page 5, lines 10-12, and page 6, lines 12-16. Thus, the specific limitations of the present claims are critical to the present invention, and it is improper for the Examiner to rely solely on case law regarding allegedly "routine expedients" or common design choices as the rationale to support an obviousness rejection.

In light of the above, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-19 under 35 U.S.C. § 103.

CONCLUSION

Applicants submit that claims 1-19 are in condition for allowance, which action is respectfully requested. The Examiner is invited to telephone the undersigned agent if such would further prosecution.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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